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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/586,518 | 07/18/2006 | Mario Steinborn | ZAHFRI P874US | 4573 |
| 20210 7590 04/14/2009 DAVIS & BUJOLD, P.L.L.C. 112 PLEASANT STREET CONCORD, NH 03301 | | | | |
| EXAMINER | | | | |
| PRICE, CRAIG JAMES | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3753 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 04/14/2009 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/586,518

Applicant(s)

STEINBORN ET AL.

Examiner

Craig Price

Art Unit

3753

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-893)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 7/18/2006

DETAILED ACTION

Claim Objections

Claim 8 is objected to because of the following informalities: line 13, "an d" should be - - and - -. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation, "has at least one valve that the function of an opening valve and a closing valve", is unclear as to the functioning of the one valve being able to open or close or if there is more than one valve.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 4-9 are rejected, as best understood, under 35 U.S.C. 103(a) as being unpatentable over Stephenson et al (6,467,264) in view of Hermann (3,851,566).

Stephenson et al. disclose a switch (10) for a vehicle transmission having valves, that are linked with each other on a pressure line (near 20) and a pressure exhaust line (near 46) and a switch chamber (18,19) of a switch cylinder (16), each switch chamber (18,19) of the switch cylinder (16) has least one valve (21,22) "that the function of an opening valve (21) and a closing valve (22) can be represented".

Stephenson et al. is silent to having a system where the pressure line and the pressure exhaust line is one of at least separately closed, opened, blocked and swapped by at least one additional valve, in event of a failure of an assigned opening valve on the switch chamber of the switch cylinder, an assigned closing valve on the switch chamber of the switch cylinder takes over and reverses the function of the assigned opening valve on the switch chamber of the switch cylinder, and first and second pair of additional valves.

Hermann discloses a system where the pressure line (32) and the pressure exhaust line (35) is one of at least separately closed, opened, blocked and swapped by at least one additional valve (15).

Firstly, It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ an additional valve as taught by Hermann in order to control a double acting consumer (Col. 5, Lns. 50-54).

Secondly, it would have been obvious to one of ordinary skill in the art to duplicate an additional valve as taught by Hermann to have a first and second pair of

additional valves, since it has been held that a mere duplication of essential working parts of a device involves only routine skill in the art.

The above combination provides the ability to perform the functionally recited limitations, where "in event of a failure of an assigned opening valve on the switch chamber of the switch cylinder, an assigned closing valve on the switch chamber of the switch cylinder takes over and reverses the function of the assigned opening valve on the switch chamber of the switch cylinder, and first and second pair of additional valves". Furthermore, "while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function", See MPEP 2114 [R-1].

Regarding claims 5, 7 and 9, Stephenson et al. disclose that the opening valve and the closing valve are one of directional valves, proportional valves and a combination of a directional valve and a proportional valve (Col. 3, Lns. 40-44).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Craig Price whose telephone number is (571)272-2712. The examiner can normally be reached on 7AM - 5:30PM Mon-Thurs, Increased flex time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Huson can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CP 2 April 2009
/C. P./
Examiner, Art Unit 3753

/John Rivell/
Primary Examiner, Art Unit 3753